

**REMARKS/ARGUMENTS**

Claims 1 through 21 remain in this application. Claims 17 through 21 have been added, and claim 14 has been amended.

Claims 1 through 13, 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,668, 167 to McDowell, et al. ("McDowell, et al. patent") in view of U.S. Patent No. 5,898,679 to Brederveld, et al. ("Brederveld, et al. patent").

To establish a prima facie case of obviousness, and hence to find claims 1 through 13, 15 and 16 unpatentable under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based upon applicant's disclosure. MPEP at § 2143.

Turning to the rejection of the claims under 35 U.S.C. § 103(a), the applicant submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, because, *arguendo*, one of skill in the art would not be motivated to combine these references as suggested in the Office action. MPEP at § 2143.01. In fact, the McDowell, et al. patent teaches away from broadcasting presence information to multicast devices. The

McDowell, et al. patent describes a system and method for sharing information about presence on a network among mobile devices in which a mobile event server (MES) broadcasts the presence of a cellular telephone user to instant messaging services (see col. 5, lines 40 through 54, and col. 6, lines 24 through 31). Although presence information is provided to wireless devices, the system and method of the McDowell, et al. patent only broadcasts presence information to instant message services, not multicast devices as required by claims 1 and 9. Thus, the multicast network and method of the Brederveld, et al. patent operates in a manner contrary to the operation of the system and method of the McDowell, et al. patent. Accordingly, the multicast network and method of the Brederveld, et al. patent may not be combined with the system and method of the McDowell, et al. patent in the manner suggested by the above Office Action. Claims 1 and 9 distinguish patentably from the Brederveld, et al. patent, the McDowell, et al. patent and the combination of these patents.

Claims 2 through 8 and 10 through 16 depend from and include all limitations of independent claims 1 and 9, respectively. Therefore, claims 2 through 8 and 10 through 16 distinguish patentably from the Brederveld, et al. patent, the McDowell, et al. patent and the combination of these patents for the reasons stated above for independent claims 1 and 9.

In view of the above, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 1 through 13, 15 and 16 are respectfully requested.

The Examiner has acknowledged that claim 14 is directed to allowable subject matter. Since there are several distinguishing features of claim 14, this claim has been separated into

amended claim 14 and new claims 17 through 19. Therefore, allowance of amended claim 14 and new claims 17 through 19 is believed warranted.

New claims 20 and 21 are provided to more particularly cover certain aspects of applicant's system and method. In particular, claims 20 and 21 provide, *inter alia*, a system and method of providing a plurality of multicast messages in which each message is directed to a particular group of multicast devices and includes presence information about the particular group of multicast devices. The McDowell, et al. patent and the Brederveld, et al. patent do not describe or suggest providing a plurality of multicast messages as required by claims 20 and 21. Therefore, allowance of new claims 20 and 21 is believed warranted.

### CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner have any

Serial No. 10/038,185  
Amdt. dated June 14, 2004  
Reply to Office Action of April 22, 2004

Attorney Docket No. PF02248NA

questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Please forward all correspondence to:  
Motorola, Inc.  
Law Department (HDW)  
600 North US Highway 45, AS437  
Libertyville, IL 60048

Respectfully submitted,  
Mathis, James Earl

 06/14/04

Hisashi D. Watanabe Date

Attorney for Applicant(s)  
Registration No. 37,465  
Telephone: (847) 523-2322  
Facsimile: (847) 523-2350